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REMARKSRejections

Claims 1, 33-39, 41-44, 52, 56, 58-59 stand rejected under §102 as anticipated by De Bey.

Claims 1, 33-37, 49, 52, 54-56, 58-59 stand rejected under §102 as anticipated by Lang.

Claims 38 and 41-42 stand rejected under §103 as unpatentable over Lang in view of Rovira.

Claims 39-40, 45-48, 50-51, 53 and 57 stand rejected under §103 as unpatentable over Lang in view of the Official Notice.

De Bey and the associated rejections are new in this action. It appears that the remaining rejections citing Lang under §102, Lang and Rovira under §103, and Lang and Official Notice are identical to the rejections made earlier in the Office Action having a mailing date of February 6, 2004.

Responsive to those rejections, Applicant earlier argued against and traversed them. In response, in the current Office Action, in addition to repeating the earlier rejections essentially word-for-word, the Examiner further stated in his "Response to Arguments" that "The art rejections are maintained and the allowability of claims indicating the previous action is withdrawn in view of De Bey. . ." In terms of the Examiner repeating the earlier prior art rejections, he said in pertinent part at paragraph 2:

Thus the structural limitations of claim 1, including tuner, memory, user interface, controller and speech subsystem are disclosed in De Bey and Lang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

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Traversal and Response to Repetition of Earlier Rejections

As pointed out above, the Examiner essentially repeated the rejections under §102 citing Lang, and under §103 citing Lang in view of Rovira and Lang in view of Official Notice. All of these rejections were earlier traversed in the Response to Office Action filed in this case dated April 30, 2004. Again, all of these rejections citing Lang, Rovira and Official Notice are traversed here again for the same reasons. Indeed, the Examiner appears to have ignored that aspects of the present claims are not disclosed or suggested in Lang, even in combination with Rovira and Official Notice. In brief, as stated above, although the Examiner read portions of Claim 1 on Lang, citing Lang Figure 3, column 8, lines 38-50 and column 11, line 30 as well as column 11, lines 32-40 and column 8, lines 27-33 as disclosing the "database" and "set of menus describing the database". However, it is not seen where in Lang there is any reference to "database" or similar structures nor does Lang have any reference to a "set of menus" or "menus".

There is description of a single menu in Lang at column 6, beginning line 53, not cited by the Examiner, which states in pertinent part "A user interface control panel of DCU 14 allows a user to select a desired frame number from a menu on the display." Therefore the only disclosure in Lang relevant to a menu appear to be this passage disclosing only a single menu which merely shows a list of frame numbers to identify strips of frames. Presumably the user enters one of these frame numbers to select a desired strip.

However, Lang has no disclosure of any "set of menus"; only the single menu is provided. This is consistent with the use of a VCR (the storage device in Lang) which only allows access by time or perhaps frame numbers (also time-based) and not by any other method relating to the recorded material. There is no indication of a "database" in Lang. Instead, in Lang recorded material or programs is merely recorded on videotape by conventional sequential video tape recording and hence is only accessed by time sequence or frame number. There is no reason to regard this as "database"; it is merely a method of reading out portions of the sequential recording based on time or frame number.

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Thus the rejection of Claim 1 citing Lang under §102 is traversed. There is no disclosure of a "database" as recited in Claim 1 in Lang. Presumably the Examiner regards the Lang recorded program material as being a "database" because portions (frame strips) can be selected. However, the selection of frame strips by Lang is based only on frame number, not on any other attribute. It is not seen how this is a "database" since there is no organization or access beyond the conventional VCR recording by sequential time, or frame number. There is no device or process in Lang for choosing a particular program or type of program or designating, for the user, which program or portions of a program he is selecting except by frame number. Hence it is not seen how the relevant passage of Lang (or any other) meets the claimed "database" of Claim 1.

Additionally, given Lang's simple approach to accessing material by frame number for editing purposes, Lang also fails to meet in Claim 1 "a user interface for providing a set of menus describing the database". At most in Lang there is a single listing of a set of frame numbers, as set forth above. There is no "set of menus". Moreover, it is not seen how the Lang single menu describes any "database", first because there is no database in Lang, and second because there is no actual identification or description provided of anything in the Lang "database". There is only a listing of frame numbers indicating particular strips. Hence, while arguendo, Lang has a user interface which accepts user selections, Lang fails to meet the remaining portion of the second clause in Claim 1 "the user interface for providing a set of menus describing the database, and for accepting selections from a set of menus".

For those additional reasons, the Claim 1 rejection citing Lang under §102 is traversed. Lang fails to meet at least two aspects of Claim 1, both the database and the set of menus.

The Examiner did not address this point in his current rejection, either in his Response to Arguments or his detailed rejections citing Lang under §102. The Examiner appears to have ignored these aspects of Claim 1 as being effective limitations and instead merely states that the tuner, memory, user interface, controller and speech subsystem are disclosed in Lang. However, in order to meet Claim 1, Lang also has to meet all the other aspects of Claim 1 including the database and set of menus, which are clearly absent from Lang. The Examiner is not entitled to ignore

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aspects of the claim. If The Examiner is suggesting that in Claim 1 the set of menus or the database are not "structural" aspects, he is requested to point out why this is the case and why he can disregard these aspects of Claim 1, which by law must be met by the reference to anticipate the claim.

Hence, it is not seen how either the Examiner's detailed claim rejections under §102 in the Office Action or his Response to Arguments effectively points out how Lang either meets or makes obvious Claim 1. Hence the traversal of this rejection of Claim 1 citing Lang under §102 is repeated here and it is respectfully submitted the Examiner failed to explain why his rejection should stand.

The claims dependent upon Claim 1 clearly distinguish over Lang for at least the same reasons as does base Claim 1, and Rovira and Official Notice fail to make good this deficiency in Claim 1.

Claim 58 is the other independent claim and stands similarly rejected as anticipated by Lang. For the same reasons as pertain to Claim 1, this rejection is again traversed. Again the Examiner identified Lang as disclosed "storing the received information in a database"; and "providing a set of menus described in the database" as recited in method Claim 58. However, as pointed out above in connection with the Claim 1 rejection traversal, Lang does not provide a "database" nor suggest same, nor does he provide a "set of menus" describing any type of database. Hence at least for the same reasons as those pointed out above in connection with Claim 1, Claim 58 also distinguishes over Lang and hence the rejection of Claim 58 citing Lang is again traversed.

Claim 59 is dependent upon Claim 58 and hence allowable for at least the same reason as base Claim 58.

Hence it is respectfully submitted that all of the repeated claim rejections citing Lang under §§102 and 103 should be reconsidered and withdrawn by the Examiner.

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Claim Amendments

All apparatus Claims 33 through 57, dependent upon Claim 1, have been amended in the same way to replace "device" in the preamble with "receiver" for clearer antecedent basis in base Claim 1, which recites "A receiver". This amendment is merely to improve form and not intended to be limiting and is not in response to any patentability rejection or for reasons of patentability and does not narrow the claims.

Rejections Citing De Bey

The Examiner made a new rejection citing De Bey under §102 as meeting Claims 1, 33, 39, 41-44, 52, 56 and 58-59 as stated above. The Examiner stated in pertinent part that De Bey discloses:

a memory coupled to the tuner for storing data in the received broadcast signal in a database, see figure 2 (4-2, 4-2);

a user interface for providing a set of menus describing the database, and for accepting selections from the set of menus, see figure 2 (54, 44);

The anticipation rejection citing De Bey is traversed. It is respectfully submitted that De Bey discloses no menus or set of menus and no database. De Bey does disclose a receiver which stores received information. However, the stored information is extremely limited, representing a very brief amount of information for each transmitted program. It is not believed that this constitutes a database, and also there is no associated menu or set of menus. The amount of memory in De Bey's receiver 40 (see Fig. 2) is strictly limited and has a very limited purpose. See De Bey page 10, beginning line 34:

Each receiver 40 typically comprises a buffer memory 42 for storing the video segments of the video program transmitted from the head end, and video processing means for processing the video segments stored in the buffer memory and supplying the segments in the correct sequence to a subscriber television set 44 for viewing. Typically, the video processing

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means may include a controller 52 and a capture memory 46 for capturing the video segment data packets received over the CATV network 36 and demodulated by one or more modems 48 of the receiver. [Emphasis added.]

Further, at page 11 beginning line 12 regarding the memory:

Compressed video data packets captured in captured memory 46 are stored in buffer memory 42 from which the segments can be retrieved and decompressed in data decompressor 50 for immediate or subsequent viewing.

The issue remains as to what is actually stored in the buffer memory; this is explained at De Bey page 17, beginning line 12:

Each receiver is provided with low power buffer memory devices which are kept active at all time for receiving selected packets of video programs. Assuming there are, say, 10 core video programs, the receivers can be configured to store PKT1 of each of the 10 core video programs. . . (Emphasis added.)

Continuing in the same passage at line 19:

Hence, when a request for a core program is lodged, the first packet is already in the receiver buffer memory and can be immediately accessed for viewing while the modified scheduling algorithm is then implemented. (Emphasis added.)

Hence, the buffer memory 42 is just that – a limited capacity memory – which stores only one data packet of, for instance, 10 programs. The packets are each very brief since each program segment is divided up into multiple data packets, hence the total memory capacity as suggested by the term “buffer memory” is very limited. The capture memory 46 appears also to be limited in the same way or even more so, but certainly has no more storage capacity than the buffer memory 42. Hence there is no storage of the entire program or even program segment but only of one data packet per program. There is also no suggestion in De Bey of a “database” except in the sense that there are 10 packets from 10 programs stored. There is also no description of how the user actually accesses the programs or selects which program to view. For instance, there is no

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description in De Bey of any sort of display or audible announcement which could support to a menu, much less a set of menus. The description of the De Bey user interface appears to be largely lacking since the emphasis is on the scheduling apparatus and the other internal workings of the device rather than the user interface, if any. The receiver 40 shown in De Bey Figure 2 does not appear to have any particular user interface, except for the telephone which is used for actually ordering the programs to be downloaded. The telephone (which carries no reference number in Figure 2 and is shown as being a conventional telephone) is necessary since the distribution is by cable television, hence there being no available interface technique other than use of the telephone, see De Bey page 11, lines 18-27. Of course a telephone would not support a display or any other type of menu associated with the receiver since the telephone is the conventional home telephone connecting to the cable TV system head end, not to the receiver 40. There is the keypad 54 described in this passage, but again there is no indication of a menu or set of menus associated therewith and it is not clear how the user decides what he wants to download.

Hence there is no discussion or suggestion of any menu much less a set of menus, nor an associated database for selecting by use of menus. The memory in De Bey is very limited, storing only one packet for each program, rather than any substantial portion of the program. This is presumably an acceptable limitation since memory was expensive at the time of De Bey and hence not deemed useful for storing television programs, except for the first data packet of each program. Hence the internal memory in De Bey is limited.

Therefore, it is respectfully submitted that Claim 1 distinguishes over De Bey at least because Claim 1 calls for "a user interface for providing a set of menus describing a database." There is neither a set of menus in De Bey nor a database. Moreover, the De Bey user interface does not perform the aspect recited in the Claim 1, "the user interface for selecting data from the database in response to the accepted selections. . ." There is no database and the user interface for selecting data is also absent, since instead in De Bey the user interface (telephone) connects back to the head end rather than into the receiver, as shown in Fig. 2 and does not allow interact directly with the receiver itself.

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Hence, clearly De Bey does not meet Claim1 which thereby distinguishes thereover. Claim 58 distinguishes over De Bey for similar reasons and is also allowable as are the claims dependent thereon. Hence the De Bey rejection is traversed and it is requested that it be reconsidered and withdrawn.

New Claims

Applicant has added here new dependent Claim 60 and 61 which are similar, being dependent respectively on Claims 1 and 58. Claim 60 recites "The receiver of Claim 1, wherein the memory is sufficient to store data representing the content of at least one entire program." This is directed to the relatively large capacity memory provided in the Claim 1 receiver, in accordance with the present invention, allowing entire programs to be stored. This allows the user to recover and use the stored programs from the receiver even though he is not in communication with the head end, and to play back programs earlier stored in the receiver. Thus, as explained in the Summary at page 2, beginning line 22 "The system and method described below permits the user to listen to the specified content of information when and where he or she wants to." Of course this does not require being in contact with the head end transmitter since entire programs are stored in the receiver memory. The extent of the receiver memory is further disclosed at page 5, beginning line 10 "In another embodiment this memory may consist of a non-volatile storage medium. . .with sufficient capacity to store information for 10 hours of audio." Hence multiple programs can be stored in their entirety in the receiver for later playback, independent of being in contact with the head end transmitter.

While the exact words of new Claim 60 are not recited in the specification, it is respectfully submitted there is support for Claim 60 in the description of the storage of 10 hours of content, whereas of course the typical program would be for instance 5 or 10 or 30 or 60 minutes long. Hence at a minimum the subject matter of Claim 60 is inherent in the disclosure. (See MPEP §2163.07(a) stating that adding by amendment an inherent function or property does not constitute new matter.)

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Claim 60 distinguishes over De Bey which stores only a single data packet for each of 10 programs. De Bey does not store even one entire program. It is also not seen how Rovira or Lang provide such receiver storage capacity or even suggest same. Hence Claim 60 additionally distinguishes over the references and is allowable, in addition to the fact it is dependent upon base Claim 1.

Claim 61 similarly distinguishes over the references for the reasons as pertain to Claim 60, in addition to the fact that Claim 61 is dependent upon allowable base Claim 58.

In view of the above, all presently pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 549222000101.

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Respectfully submitted,

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